

REMARKS AND ARGUMENT

REMARKS

The examiner must adhere to the following basic tenants of patent law:

1. The claimed invention must be considered as a whole;
2. The reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination (or modification) of the prior art;
3. The reference must be viewed without the benefit of hindsight vision afforded by the claimed invention;
4. Reasonable success of the modified prior art is the standard with which obviousness is measured. MPEP 2141.01.

The MPEP provides four criteria must be considered in rejecting claims under 35 USC 103:

1. determining the scope and content of prior art;
2. ascertaining the difference between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence presented in the application. MPEP 2141.

The examiner bears the initial burden of establishing a prima facie case supporting the conclusion of obviousness. Otherwise, the applicant is under no obligation to submit evidence of non-obviousness. MPEP 2142, 2143.

Establishing the prima facie case requires:

1. showing and establishing some motivation or suggestion in references or knowledge in general to modify or combine references;
2. establishing some reasonable expectation that the modification of the prior art would be successful; and
3. establishing that prior art references show or at least clearly suggest all of the limitations of the rejected claims.

Clear and reasonable basis must be established to justify modifying or combining references to support a finding of obviousness. In re Fine, 837 F.2d 1071, 5 U.S.P.Q2d 1596 (Fed. Cir. 1988). The examiner found that substituting a system for monitoring sulfur compounds described in the cited prior art rendered obvious to one skilled in the art a system for detecting and measuring nitrogen compounds. The court found that no support was given for the conclusion. Id. Although the prior art and application both addressed chemical analysis, that similarity did not constitute "obviousness."

The proposed modifications of the prior art necessary to establish "obviousness" of the applicant's claims cannot render the prior art useless. In re Gordon, 733 F.2d 700, 221 U.S.P.Q. 1125 (Fed. Cir.1984). The examiner found that a prior art comprising a fuel

filter could be inverted and to make obvious a claimed blood filter. Although the inversion would allow the fuel filter to function as the claimed blood filter, inversion destroyed the function of the fuel filter. Inversion led directly to plugging of the fuel filter with debris, thereby destroying its intended function. The fact that the inversion destroyed the intended purpose of the fuel filter violated the requirement that modification must not destroy the intended purpose of prior art.

Review of US Patent 5,218,344

The examiner has based all rejections on US 5,218,344 issued to Ricketts on June 8, 1993. The applicant does not dispute that temporally the '344 patent constitutes prior art. The argument simply stated is that depending on the cited art fails to establish a prima facie of obviousness and that otherwise it does not constitute prior art appropriate to sustain rejection of claims base on 35 USC 103. Consider the '344 patent in its entirety and in details as such related to the rejections.

The title of the '344 patent describes the subject matter of the patent, "Method and System for Monitoring Personnel." The field of the invention specifically describes the invention as monitoring the location and identity of individuals from a remote station, and especially for locating, identifying, and counting individuals in correctional facilities. Col 1, lns 7 - 11.

The Summary of the system of the '344 invention characterizes the stated objectives of the invention, col 3 lns 66 - 68 through col 6 ln 11.

An objective of the invention is described in the summary as a system to count individuals any time at any location. Col 3 lns 66 - 68 and col 4 lns 1 - 4. A further objective of the invention is the capability of warning an individual as he/she approaches a restricted or prohibited area. Col 4 lns 9 - 11, and an additional objective comprises the ability to send emergency calls for assistance. A related objective is a warning an individual of approaching danger. Col 4 lns 15 - 20.

The objectives are achieved by an electronic monitoring system comprising three interrelated/interacting elements: a personal detection device (described as a transceiver) worn by individuals whose location is to be monitored, at least one (and preferably three) stationary transceivers located throughout the facility in predetermined areas, and a central processing unit (computer) capable of processing data from interaction (communication) between the individual, personal detection devices and each stationary transceiver. An important feature of the system is the ability of the detection units (individual transceivers) to communicate among themselves based on preestablished parameters. Col 4 lns 33 - 45.

In a detailed description of the invention described as a preferred mode, the system is described as:

The system includes a main computer or central processing unit 11, preferable positioned in a centrally located room. The computer is hard wired or otherwise suitably connected with a plurality of stationary transceivers 12 located throughout the facility and each inmate wears a portable transceiver or wrist unit 13, preferably in the form of a wrist unit, that interacts via suitable signals transmitted through the air with one or more stationary transceivers in that person's vicinity. Col 6 lns 24 - 33.

A designated "important feature of the invention" is the ability of the individual transceiver units to communicate with each one another. This allows warnings of potential contacts/conflicts of incompatible individuals. Col 6 lns 34 - 39.

The system of the '344 patent locates "inmates" on a current time basis based on communication from an individual, portable transceivers in response to inquires from one or more of the stationary transceivers. Time intervals between the inquiry from a stationary transceiver and reply from a specific portable transceiver worn by a specific individual are used to fix the location of that individual through a triangulation-like process. Col 7 lns 60 - 65 and Col 8 lns 60 - 62.

The system of the '344 patent may include a second, local computer 15 to relay signals between the stationary transceivers 12 and the main computer. Col 6 lns 44 - 47. This second optional computer is used in physically large areas of a facility.

ARGUMENT

The reference invention comprises a central processing unit (main computer) that communicates with portable transceivers through a group of individual, stationary transceivers. A local computer the function of which is to relay information between the main computer and stationary transceivers that also communicate with individual, portable transceivers worn by individuals. Individual-specific, identification data are loaded into the main computer, and complimentary data for the individual is loaded into the portable transceiver worn by the individual. The main computer is programmed to instruct the stationary transceivers to transmit inquiries to specific portable transceivers, and each queried portable transceiver responds with unique information in response to the query to one or more stationary transceivers that in turn transmit the requested, individual replies and related information to the main computer for processing. The "reply" from each individual transceiver verifies the presence of the transceiver (and presumably of the wearer) in the facility. The location of each replying portable transceiver in can be established. The system requires no action by the wearer of the portable transceiver

and in fact the queries can be completed unknown to the wearer.

By contrast, the claimed invention requires the individual to enter specific, personal identification data into a main computer by means of a card reader or similar device on entering the facility. This act establishes the individuals presence in the facility, but provides no specific location information (although the input identification data may be associated with a work station (office) where the individual would most likely be during the work day). It may also include personal information as to special needs or assistance required in the event of an emergency. On exiting the building under normal conditions the individual again enters the same personal identification data and that individual is deleted from a current occupancy census list. In the event of power outage or other emergency, the current occupancy census data are transmitted to a remote, second computer to avoid loss in the event of damage to or shut down of the main computer. In addition an array of remote, individually powered egress, personal identification readers (card readers) is activated at specified sites such that individuals evacuating the facility can indicate egress after safe evacuation from the facility. These egress data are communicated to the second computer so that the current status of evacuation can be determined and the identification of evacuees and individuals not indicated by an egress report can be ascertained rapidly, thus allowing more efficient use of emergency workers and resources.

The system of the cited references does not suggest modification making the claimed invention obvious. The systems are far too different. The system of the cited reference depends on personal data entered into a base computer and on a complex intercommunicating computer network. The system reflected in the claims at issue depends on data individually entered on ingress and egress. In emergency conditions and during evacuations, ingress data are transmitted to a second computer, the system is operated on free standing auxiliary power, and egress can be entered at remote sites to generate a census of the progress of evacuation of the facility when individuals are safely removed from the emergency. Consider now, the specific rejections in light of the foregoing.

In rejecting claim 1, the examiner finds with respect to the '344 patent that the at least one first card reader is met by the one of the stationary transceivers 12; the base computer by the main computer 11; the plurality of second card reader means by the transceivers designated (B,C), and the portable computer is met by the local computer 15. How the card readers are "met" is not explained or justified.

The assertions raised concerning suggested wireless communication are acknowledged. Wireless communication may be elected for a variety of reasons. With respect to the reference, the examiner

suggests possible cost reductions in construction. This might be true, although the costs of the wireless technology must be considered, and it was ignored. In the analysis of the obviousness of the wireless communication, the examiner apparently did not appreciate that in the claims at issue, the system depends on wireless communication to compensate for potential loss of hard-wiring in the event of an emergency. This at least suggests that the examiner failed to consider the invention as a whole as required by MPEP 2141.01.

The examiner refers to a portable computer 15 in contact with the base computer (identified in the '344 patent as the central processing unit). However, the reference appears clear at the end of the last sentence, page 3, detailed action in which the examiner concludes that the local computers 15 are described as an extension of the main computer 11.

Modification of the local computers to include all functions of the main computer is not justified. Modification must be suggested by the reference or by general knowledge following MPEP 2142 and 2143. The reference as previously described characterized the local computer as a means to relay signals between the main computer and the stationary transceivers. This specific and described exclusive function does not suggest modification and general knowledge is not provided to support the unexplained increased role and function of the local computer. Obviousness is not supported by the local computer because its modification is not supported as required.

The examiner has failed to adhere to the basic tenants of patent law applicable to rejections based on 35 USC 103. Although the several major elements of the cited art have been equated with parts of the invention, the fundamental difference between the cited art and the invention is seemingly ignored. The cited art involves an inter-communicating system comprising at a minimum of portable transceivers worn by inmates (or others to be tracked), stationary transceivers that communicate with the portable transceivers, and a central processing unit. It also includes a local computer the function of which is to relay signals to the central unit.

Consider first the suggested role of the portable transceivers as either a first card reader or as the plurality of second card readers. One skilled in the art recognizes that a transceiver is capable of communication, both sending and receiving instructions and information and responding to the same. A card reader (whether it is a first or second card reader) has a very limited function: as the name implies, the card reader reads specific information from a card or similar device and conveys that information to a designated point (frequently a computer). As one skilled in the art recognizes, nothing in the structure/function of a transceiver suggests it could or should substitute for a card reader, and nothing in the cited reference suggests this modification. By

analogy, the logic and holding in re Fine is highly relevant.

According to In re Fine a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector did not suggest (render obvious) a system for detecting and measuring minute quantities of nitrogen comprising similar elements - a gas chromatograph, a converter to nitrogen compounds to nitric oxide by combustion, and a nitric oxide detector. Even the marked technical similarities between the prior art and the claims did not constitute sufficient grounds for a claim of obviousness. A stationary transceiver is not obviously modified to yield a card reader, even if the modification were possible and reasonable.

A modification must have a reasonable chance of success, and specifically a modification that destroys the function of the prior art cannot sustain a claim of obviousness. In re Gordon. A claimed blood filter was claimed to be obvious in view of a fuel filter in the prior art when the fuel filter was simply inverted. However, inversion of the fuel filter led to clogging of the fuel filter thereby destroying its intended function. The fuel filter could not render obvious the blood filter. The stationary transceivers of the reference play a critical role in communication among the central processing unit, the portable transceivers, and potentially the local computers. Diverting this function to that of the card reader would destroy the stated important function of communication among transceivers and thereby prevent the system from function to locate individuals. The examiner has failed to establish a prima facie case for obviousness because of the total absence in the reference or reasonably suggested otherwise to modify the reference and because the required changes render the prior art useless.

The examiner failed to adhere to a basic tenant of patent law in applying 35 USC 103 to the invention: the reference must be considered as a whole and must suggest the desirability and thus the obviousness of making the modifications. The prior art is an interacting system of transceivers capable of communication to determine, among other things, the location of an individual with in a facility. The location can be determined on demand in real time. The invention is an ingress/egress monitor that is adapted to allow individuals to utilize more than one data entry point (card reader) on exiting a facility. The only "location" information processed by the invention is effectively the office or other location at which a individual is most commonly located. The system is adapted to transfer data to an alternate computer in the event of an emergency power outage. Except for the transfer of census data, the elements of the invention do not communicate or interact functionally. Input to the system is by the use of a swipe card or similar identification information on which is read and transmitted to the main computer. The system maintains a current census of facility occupancy by individuals checking in through a card reader and on leaving checking out.

The prior art is a complex, interacting system in which at least three categories of transceivers intercommunicated to allow identification and location of an specific portable transceiver worn by an individual. The ability of the portable transceiver to communicate with stationary transceivers and the stationary transceivers to communicate with and relay instructions from a main computer is a very important feature of the system.

The prior art system has no direct or inferred obvious equivalent to the data input means (card reader and card) of the invention. Effectively, the portable transceiver contains specific information identifying the individual, thus by extreme analogy it is the card read by the card reader. The portable transceiver transmits on inquire from a one or more stationary transceivers identity and the information coupled with the location and distance from the transceiver at the time of response to the inquire are processed by a central computer to yield on demand census data and location information for any indicated individual. The significance of the interactive communication system, and the pivotal role of the portable transceivers are not addressed by the examiner in support of the rejections. Nothing in the complex, interacting system suggests its modification to yield the claimed invention or any benefit of the claimed invention. The examiner failed to adhere to a fundamental tenant of patent law, and in this instance, that failure also led to the insupportable conclusion that the invention was made obvious by modifications of the prior art.

With respect to the rejection of claim 1, the above discussion established that (1) the examiner failed to establish a prima facie case of obviousness based on the fact that the modification destroyed the intended function of the prior art and (2) that claimed grounds for obviousness were not valid based on cited cases and regulations cited in the MPEP.

The examiner's conclusion that the local computer 15 is an extension of the central processing unit 11 is contra to the its role and function as described in the prior art: to relay signals. Nothing in the cited reference suggests or supports the examiner's conclusion that "the local computers are an extension of the main computer." The function is limited by the description to that of a relay. Thus, it is not obvious that the local computers 15 have the capacity to process, display, and generate printed displays of census data transmitted from the base computer. The local computer of the cited art does not render obvious any element claimed in the invention because of its clearly expressed, limited function in the prior art.

Claims 2 through 10 depend from claim 1, and claims 11 and 12 depend from claim 10. Claim 13 is an independent claim. The examiner justifies rejection of claim 13 simply by asserting that claim 13 asserts subject matter met as discussed in claim 1. Rejection of claim 1 has been refuted in detail. Since rejections

of claim 12 and 13 are based exclusively on the grounds of the rejection of claim 1, the rejection is fully refuted by the fact noted above that based on the preceding Argument, the rejection of claim 1 based on obviousness cannot be maintained and on that basis and logic the rejection of claim 13 similarly cannot be maintained.

With respect to claim 2, because the base claim 1 is non-obvious as has been established above, any limitation to claim 1 expressed in claim 2 depending from claim 1 cannot be obvious.

Claims 3 through 8 depend from claim 1 and each specifies a specific further restriction on the limits of claim 1. In as much as claim 1 satisfies the requirement of non-obviousness, any claim depending from it should similarly satisfy the requirement of non-obviousness; the additional restrictions to a non-obvious claim can not render it obvious.

Placing the invention of claim 1 in the facilities of claims 3 through 8 is not obvious because the invention of claim 1 is not obvious. The non-obvious invention does not become obvious by as a result of the further limitation of specific placement.

The logic of claims 3 through 8 apply in concluding that claim 9 satisfies the non-obviousness requirement because of its dependency from claim 1. The same logic must apply to claim 10. Addition of the limitation of automatic activation of an alternative energy system to major elements to an otherwise non-obvious invention does not render invention obvious. The system taken as a whole is non-obvious; thus, limitations on the system are similarly non-obvious.

Following the logic applied to claim 10, claim 11 depending from claim 10 is similarly non-obvious.

CONCLUSIONS

The examiner has failed to establish a prima facie case of obviousness as required by in MPEP 2143 in terms of finding in the prior art some motivation to modify the reference so as to support the finding of obviousness as described in In re Fine and In re Gordon. No basis for modifying the reference is established and modifications critical to the argument of obviousness destroy the function of the reference.

REQUEST

The undersigned Attorney for the Applicant on behalf of the Applicant respectfully requests that the examiner reconsider and withdraw the rejection of claims 1 through 13, allow these claims and declare the application in condition to issue.

The undersigned Attorney for the Applicant personally and on behalf of the Applicant extends his sincere thanks and appreciation to the

examiner to the thoughtful analysis and consideration given to the examination to this application.

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